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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,987

08/18/2003

Ming-Chun Hou

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05/11/2006

EXAMINER

BIRCH STEWART KOLASCH & BIRCH

PO BOX 747

FALLS CHURCH, VA 22040-0747

CANTELMO, GREGG

ART UNIT

PAPER NUMBER

1745

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/642,987	HOU, MING-CHUN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gregg Cantelmo	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. <u>5/5/06</u> .                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species:

- a. Species I, claims 1-9, wherein the elastic apparatus is configured on the battery cover;
- b. Species II, claims 10-18, wherein the elastic apparatus is configured on the device body.

The species are independent or distinct because the two claimed embodiments are divergent from one another with respect to the elastic apparatus and the search for each species would not be coextensive.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations

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of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

2. During a telephone conversation with Mr. Joe McKinney Muncy on May 4, 2006 a provisional election was made with traverse to prosecute the invention of Species I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Information Disclosure Statement***

3. No IDS appears to have been filed with the application prior to this office action.

***Drawings***

4. The drawings received August 18, 2003 are acceptable for examination purposes.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-284026 A (JP '026).

JP '026 discloses an assistant apparatus 18 for a battery cover 14, in a portable electronic device, the portable electronic device having a device body 10 and a battery

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cover 14, the battery cover 14 being attached to the device body by a latch structure 15/16, the assistant apparatus 18 for a battery cover 14 comprising: at least one elastic apparatus 18, configured on a first surface of the battery cover, the first surface adjacent to the device body 10, wherein a force of the elastic apparatus separates the battery cover from the device body after releasing the latch structure (Fig. 3 as applied to claim 1).

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114.

The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural

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limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

It is held that the prior art apparatus of JP '026 is structurally identical to that of claim 1 and inherently the elastic member 18 of JP '026 provides the same relative functionality of claim 1.

The portable electronic device is a mobile phone or a personal digital assistant (Fig. 3 as applied to claim 2).

6. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 08-273642 A (JP '642).

JP '642 discloses an assistant apparatus 2a for a battery cover 16, in a portable electronic device, the portable electronic device having a device body and a battery cover 16, the battery cover 16 being attached to the device body by a latch structure 19, the assistant apparatus 2a for a battery cover 16 comprising: at least one elastic apparatus 2a, configured on a first surface of the battery cover 16, the first surface adjacent to the device body, wherein a force of the elastic apparatus separates the battery cover from the device body after releasing the latch structure (see Figures as applied to claim 1).

The battery cover comprises batteries A (as applied to claim 3).

The assistant apparatus 2a is a metal spring leaf, the metal spring leaf including a first portion and a second portion, wherein the first portion is attached to the first surface of the battery cover, and the second portion is at a 90 degree angle with the first portion, thus when the battery pack and cover are inserted into the portable electronic

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device, and engaged by the latch, the second portion of terminal spring 2a is compressed to impart tension and electrical contact between the battery pack/cover and electronic device and the compression alters the angle to an extent and after releasing the latch structure, the compressed second portion of terminal spring 2a forces the battery pack/cover from the body of the electronic device (see figures and abstract as applied to claim 4).

The elastic apparatus 2a is a spring (figures as applied to claim 5).

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,155,659 (Kunert).

Kunert discloses an assistant apparatus 70 for a battery cover 39, in a portable electronic device, the portable electronic device having a device body and a battery cover 39, the battery cover 39 being attached to the device body by a latch structure, the assistant apparatus 70 for a battery cover 39 comprising: at least one elastic apparatus, configured on a first surface of the battery cover, the first surface adjacent to the device body, wherein a force of the elastic apparatus separates the battery cover from the device body after releasing the latch structure (Fig. 5 as applied to claim 1).

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference

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as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114.

The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

It is held that the prior art apparatus of Kunert is structurally identical to that of claim 1 and inherently the elastic member 70 of Kunert provides the same relative functionality of claim 1.

The portable electronic device is a mobile phone or a personal digital assistant (Fig. 1 as applied to claim 2).

8. Claims 1-2 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art of U.S. Patent No. 5,942,352 (Neil).

Neil discloses an assistant apparatus 18 for a battery cover 10, in a portable electronic device, the portable electronic device having a device body and a battery cover, the battery cover being attached to the device body by a latch structure, the assistant apparatus 18 for a battery cover comprising: at least one apparatus, 18



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configured on a first surface of the battery cover, the first surface adjacent to the device body, wherein a force of the elastic apparatus separates the battery cover from the device body after releasing the latch structure (Figs. 1-4 as applied to claim 1). While the invention of Neil is to the particular pillar material, it is apparent that the prior art pillar materials were an elastomeric material (col. 1, ll. 20-23). Therefore the prior art configuration is taught to be the same structure but using different materials for member 18. In light of the fact that the prior art uses an elastomeric material, the prior art of Neil is held to anticipate the assistant apparatus of claim 1.

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114.

The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

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apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

The portable electronic device is a mobile phone or a personal digital assistant (Fig. 1 as applied to claim 2).

The apparatus 18 are pillars configured in pits of the battery cover and provide the same compression and pushing as defined in claim 8).

As discussed above, the prior art spacers are elastomeric (as applied to claim 9).

9. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,290,639 (Mallory).

Mallory discloses an assistant apparatus 29 for a battery cover 13, in a portable electronic device, the portable electronic device having a device body and a battery cover, the battery cover being attached to the device body by a latch structure, the assistant apparatus 29 for a battery cover comprising: at least one elastic apparatus 29, configured on a first surface of the battery cover, the first surface adjacent to the device body, wherein a force of the elastic apparatus separates the battery cover from the device body after releasing the latch structure (Figs. 1-2 as applied to claim 1).

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim

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drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). See also MPEP § 2114.

The manner of operating the device does not differentiate an apparatus claim from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

It is held that the prior art apparatus of Mallory is structurally identical to that of claim 1 and inherently the elastic member 29 of Mallory provides the same relative functionality of claim 1.

The assistant apparatus 29 is a metal spring leaf, the metal spring leaf including a first portion and a second portion, wherein the first portion is attached to the first surface of the battery cover, and the second portion is at a angle with the first portion, thus when the battery pack and cover are inserted into the portable electronic device, and engaged by the latch, the second portion of terminal spring 29 is compressed to impart tension and electrical contact between the battery pack/cover and electronic device and the compression alters the angle to an extent and after releasing the latch

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structure, the compressed second portion of terminal spring 29 forces the battery pack/cover from the body of the electronic device (see figures and abstract as applied to claim 4).

The elastic apparatus 29 is a spring (figures as applied to claim 5).

Assistant apparatus 29 is also the same configuration as the slice defined in claim 6. Note that apparatus 29 is attached to the cover 13 and at an angle with the cover and when the cover and device body are latched, the slice is compressed (Fig. 3) and the angle of the slice 29 is changed. Upon releasing the slice 29, the slice pushes the device body so as to separate the battery cover from the device body (Figs. 1 and 2 as applied to claim 6).

The cover 13 and "slice" 29 are integrally formed (Fig. 2 as applied to claim 7).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '026 in view of U.S. Patent No. 5,158,356 (Guthrie).

The teachings of JP '026 have been discussed above and are incorporated herein.

The differences between claims 6-9 and JP '026 are that JP '026 does not disclose of the particular assistant configurations of claims 6-9.

It is apparent that JP '026 discloses the same concept of providing an elastic spacer between the battery cover and device as discussed above.

While the battery spacer of JP '026 is exemplified as a sponge material, it would have been readily apparent that other elastic means, including springs, slices and rubber pillars would have been recognized equivalent elastic spacers to that of the particular spacer of JP '026 and that replacement of the particular spacer of JP '026 with any other spacer configuration would have been readily apparent to one of ordinary skill in the art.

For example Guthrie shows that it is know in the art to use elastic pillars 7, provided in recessed pits in the cover wherein the elastic pillars impart compression in a contacted state and upon release of the contacting pressure push the battery away from the electronic device.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. KR 2001-0054451; USPAT 6,376,942; JP 10002738; JP

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04206254; JP 06324390 and JP 07142045 disclose of various assistant apparatuses for a battery cover.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



May 9, 2006

Gregg Cantelmo  
Primary Examiner  
Art Unit 1745